

### REMARKS

In the Office Action, the Abstract was objected to. Although, Applicant may not necessarily agree with the Examiner's objection, Applicant has nonetheless amended the abstract as suggested by the Examiner.

In the Office Action, the Examiner rejected claims 1-34. By this response, claims 1, 9, 18, 24, 32, and 33 have been amended. Additionally, claims 13, 14, and 30 have been cancelled without prejudice. Upon entry of the amendment, claims 1-12, 15-29, and 31-34 will remain pending. Reconsideration and allowance are respectfully requested.

The Examiner first rejected claims 9-12 and 15-17 under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the inventive subject matter. Specifically, the Examiner contends that the term "desired location", as employed in claim 9, is not clear in its constitution. Applicant respectfully disagrees with the Examiner's contention.

Although the Examiner may take exception to the terms used in the claims, he is reminded that the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7<sup>th</sup> Cir. 1971), *aff'd*. 613 F.2d 775 (7<sup>th</sup> Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Applicant respectfully directs the Examiner's attention to lines 20-24 of page 7 as well as lines 1-8 of page 8 of the present application. A review of these sections shows that sufficient support for the recited term is provided. Applicant respectfully asserts that the specification clearly supports the instant claims, and, as such, provides adequate teaching for one skilled in the art to make and use the claimed technique. Reconsideration is respectfully requested.

In the Office Action, the Examiner next rejected claims 1, 7-8, 18-21, 24-25, 27 and 32-34 under 35 U.S.C. §102(b) as being anticipated by Carter (US 3,975,117). Of the rejected claims, claims 1, 18, 24, and 32 are the independent base claims from which the remaining claims respectively depend. Applicant respectfully asserts that the rejected claims are presently patentable over the cited art.

Anticipation under section 102 can be found only if a single reference shows *exactly* what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985) (emphasis added). For a prior art reference to anticipate under section 102, every element of the claimed invention must be *identically* shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990) (emphasis added). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

As stated above, a valid §102 rejection requires that the Examiner find *all* of the recited elements within a single reference. Applicant respectfully asserts that cited reference does not contain each and every element recited in the instant claims. Claim 1 presently recites, *inter alia*, “a rotor and a stator disposed within a housing,” as well as, “an internal lubricant pump disposed within the housing and circumferentially about the shaft.” These are among some of the features not found in the cited reference. Rather, the cited reference discloses a series of pumps disposed of *external* to the housing. This is in contrast to the *internal* pump recited in the instant claim. Figure 1 of the Carter reference and its corresponding text, specifically column 3, lines 61-64, clearly indicate that the pumps 37, 56, and 79 are located outside of the motor housing 17. As such, the motor 30 and the pumps 37, 56, and 79 are not within the same primary housing. Accordingly, the cited reference fails to disclose each and every element of the instant claim. Moreover, the cited reference would not even suggest the placement of the pump within the motor housing 17. The primary teaching of this reference is the improved flow of product or primary fluids through the pump. *See Carter*, column 1, lines 8-22. As such, placing the pumps within the motor would decrease the flow rate and balance of the disclosed pump. For the above reasons, Applicant respectfully asserts that claim 1 and its respective dependent claims 2-8 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning next to independent claim 9, this claim also contains features not disclosed by the cited reference. Independent claim 9 recites, *inter alia*, “a gear pump to supply a

pressurized lubricant to a desired location within the submersible motor, wherein the gear pump comprises first and second gears adapted to pressurize the lubricant.” In contrast to the claim’s recitation, the cited reference discloses a impeller pumps 37 and 56 located within the assembly. *See Carter*, Figure 3. No semblance of first or second gears designed to pressurize the lubricant are disclosed by the cited reference. Thus, independent claim 9 and its respective dependent claims 10-12 and 15-17 are patentable over the cited reference. Reconsideration is respectfully requested.

Turning to independent claim 18, this claim also contains features not disclosed by the cited reference. Independent claim 18 recites, *inter alia*, “a gear pump internal to the outer housing and external to the shaft, the gear pump adapted to pressurized the lubricant within the lubrication system.” As stated above, the cited reference does not discloses a pump disposed of within the housing. Rather, it discloses pumps disposed of outside the motor housing 17. Moreover, the cited reference, again as argued above, does not disclose any semblance of a gear pump as recited by the instant claim. Accordingly, independent claim 18 and its respective dependent claims 19-23 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

Turning next to the independent claim 24, this claim also recites features not found within the cited reference. Claim 24 recites, *inter alia*, “pressurizing the flow of lubricant with a gear pump.” This recitation is similar to the gear pump recited in claim 18. Again, there is no suggestion of any semblance of a gear pump within the cited reference. Accordingly, every feature of the instant claim is not sufficiently anticipated by the cited reference. Applicant respectfully asserts that claim 24 and its respective dependent claims 25-29 and 31 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning lastly to independent claim 32, this claim also recites features not found within the cited reference. Claim 32 recites, *inter alia*, “a pump disposed within the outer housing and external to the drive shaft, the pump adapted to pressurize the lubricant within the lubrication system.” Again, and as argued above, the cited reference discloses no

semblance of a pump external to the drive shaft. Accordingly, not every feature of the instant claim is disclosed by the cited reference. As such, Applicant respectfully asserts claim 32 and its respective dependent claims 33 and 34 are patentable over the cited reference.

Reconsideration and allowance are respectfully requested.

The Examiner also rejected claims 1-3, 7-12, 17-21, and 24-34 under 35 U.S.C. §102(a) as being anticipated by Parmeter et al. (US 5,828,149). Of the rejected claims, claims 1, 9, 18, 24, and 32 are the independent base claims from which the remaining claims respectively depend. Applicant respectfully asserts that the rejected claims are presently patentable over the cited art.

Beginning with claim 1, this claim recites features not found in the cited reference. Claim 1 recites, *inter alia*, “an internal lubricant pump disposed within the housing and circumferentially about the shaft.” This recitation is contrary to what is disclosed in the cited reference. The cited reference discloses a helical pump 59 disposed of *within* a bore 53 of the shaft 31. *See Parmeter*, Figure 3. As such, the pump 59 of the cited reference would not be *circumferentially about* the shaft. The internal location of the helical pump prevents the cited reference from anticipating the instant claim. Accordingly, independent claim 1 and its respective dependent claims 2-8 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning next to claim 9, this claim recites, *inter alia*, “a gear pump to supply a pressurized lubricant to a desired location within the submersible motor, wherein the gear pump comprises first and second gears adapted to pressurize the lubricant.” Similar to the arguments presented above in relation to the Carter reference, the instant reference also does not disclose any semblance of a gear pump. Rather, the reference discloses a helical pump 59. Accordingly, Applicant respectfully asserts that independent claim 9 and its respective dependent claims 10-12 and 15-17 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning next to claim 18, this claim recites, *inter alia*, “a gear pump internal to the outer housing and external to the shaft, the gear pump adapted to pressurize the lubricant within the lubrication system.” Again, the cited reference fails to disclose any semblance of a gear pump. Moreover, the cited reference also fails to disclose a pump external to the shaft. In contrast, the cited reference discloses a helical pump disposed internal to the shaft. Accordingly, Applicant respectfully asserts the independent claim 18 and its respective dependent claims 19-23 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning next to claim 24, this claim recites, *inter alia*, “pressurizing the flow of lubricant with a gear pump.” Again, the recitation of a gear pump is in contrast to the helical pump disclosed in the cited reference. Accordingly, Applicant respectfully asserts that independent claim 24 and its respective dependent claims 25-29 and 30 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Turning lastly to claim 32, this claim recites, *inter alia*, “a pump disposed within the outer housing and external to the drive shaft, the gear pump adapted to pressurize the lubricant within the lubrication system.” As argued above, the cited reference fails to disclose a pump external to the drive shaft. Accordingly, independent claim 32 and its respective dependent claims 33 and 34 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Lastly, the Examiner rejected dependent claims 4-6, 15-16, and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Parmeter et al. in light of Wilson (4,367,140). Applicant respectfully disagrees with the Examiner’s rejection.

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

The Examiner, in support of the instant rejection, relies primarily upon the Parmeter et al. reference as disclosing the majority of the claimed elements. However, as argued above, the Parmeter et al. reference fails to disclose each and every element of the independent claims from which the instant claims depend. Moreover, the Wilson reference fails to satisfy the deficiencies of the Parmeter et al. reference. Accordingly, claims 4-6, 15-16, and 22-23 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

Applicant believes that all pending claims are now in condition for allowance. However, if further amendments are deemed needed to improve the form of the claims, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the Abstract of the Disclosure and to the claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Van Someren", written over a horizontal line.

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## **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

Please amend the application as follows:

### **IN THE ABSTRACT**

Please amend the abstract to read as follows:

A component, such as a submersible motor, having a lubrication distribution system. The component ~~comprises~~ includes an outer housing having a rotatable shaft disposed within the housing. The shaft is supported by one or more bearings and a lubricant is disposed within the housing. A conduit is provided for conducting a lubricant from the lubricant pump to desired locations, such as the one or more bearings.

### **IN THE CLAIMS**

Please amend the claim 1 to read as follows:

Please amend the claims to read as follows:

1. (Amended) A motor, comprising:
  - a rotor and a stator disposed within a ~~an outer~~ housing;
  - a rotatable shaft at least partially disposed within the housing;
  - a plurality of wear surfaces that support the rotatable shaft;
  - an internal lubricant pump disposed within the housing and circumferentially about the shaft, and
  - a conduit for conducting the lubricant from the lubricant pump to the plurality of wear surfaces.
9. (Amended) A submersible pumping system, comprising:
  - a submersible pump;
  - a motor protector; and

a submersible motor having ~~an internal~~ a gear pump to supply a pressurized lubricant to a desired location within the submersible motor, wherein the gear pump comprises first and second gears adapted to pressurize the lubricant.

18. (Amended) A submersible motor, comprising:  
an outer housing;  
a rotatable shaft;  
a stator disposed within the outer housing;  
a rotor rotatably mounted within the stator;  
a lubrication system to distribute a lubricant to one or more desired locations within the outer housing; and

a gear pump internal to the outer housing and external to the shaft, the gear pump adapted to pressurize the lubricant within the lubrication system.

24. (Amended) A method for increasing the life expectancy of a subterranean completion having a submersible motor, comprising:

directing a flow of lubricant to an area of the submersible motor benefiting from lubrication; and

pressurizing the flow of lubricant with ~~an internal~~ a gear pump.

32. (Amended) A submersible component, comprising:

an outer housing configured for submersion in a liquid;

a rotatable drive shaft;

a lubrication system disposed within the outer housing to distribute a lubricant to one or more desired locations within the outer housing; and

a pump disposed within the outer housing and external to the drive shaft, the pump adapted to pressurize the lubricant within the lubrication system.

33. (Amended) The submersible component as recited in claim 32, ~~further comprising~~ a drive shaft wherein the lubrication system extends at least partially through the drive shaft.